

REMARKS

The last Office Action of August 8, 2005 has been carefully considered. Reconsideration of the instant application in view of the foregoing amendments and the following remarks is respectfully requested.

Claims 20-47 are pending in the application. Claims 26-29 have been withdrawn from further consideration. Applicant herewith affirms the withdrawal of claims 26-29 from further consideration and prosecution of claims 20-25 and 30-47 is desired¹. Claims 20, 30, 31, 32 and 35 have been amended. No claims have been canceled. No claims have been added. A total of 24 claims is now on file. No claim surcharge is due.

It is further noted that claim 35 is rejected under 35 U.S.C. §112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 20, 23-25, 30-32 and 36-37 stand rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Pat. No. 4,375, 219 to Schmid (hereinafter referred to as "Schmid").

Claims 33-34, 38-40, 43-45 and 47 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Schmid.

Claim 21 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Schmid in view of U.S. Pat. No. 3,752,151 to Robichaud, (hereinafter referred to as "Robichaud").

¹ The Office Action states on page 3 that election was made to claims 20-25 and 30-37[sic] it is clear that this is merely a typo and should read 30-47, which is clear from the context.

Claim 22 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Schmid in view of U.S. Pat. No. 3,816,293 to Ueda, (hereinafter referred to as "Ueda").

Claims 35 and 41-42 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Schmid in view of U.S. Pat. No. 4,668,840 to Kiyama, (hereinafter referred to as "Kiyama").

Claim 46 stands rejected under 35 U.S.C. §103(a) as being unpatentable over Schmid in view of U.S. Pat. No. 5,822,177 to Popp, (hereinafter referred to as "Popp").

REJECTION OF CLAIM 35 UNDER 35 U.S.C. §112, SECOND PARAGRAPH

Applicant has amended claim 35 to address the §112 rejection. These changes are self-explanatory and cosmetic in nature and should not be considered as a narrowing amendment to trigger prosecution history estoppel.

As a result of the amendment of claim 35, the rejection under 35 U.S.C. §112, second paragraph becomes moot.

Withdrawal of the rejection of claim 35 under 35 U.S.C. §112, second paragraph is thus respectfully requested.

**REJECTION OF CLAIMS 20, 23-25, 30-32 AND 36-37 UNDER 35 U.S.C.
§102(b) AS BEING ANTICIPATED BY SCHMID**

The rejection under 35 U.S.C. 102(b) is respectfully traversed.

In order to clearly distinguish the present invention from Schmid, applicant has amended claim 20 and 30 by setting forth that the Germanium content of the medical instrument according to the invention comprises up to 3% Germanium. Schmid, on the other hand discloses a composition in which the electrode contains 5% by weight Germanium (see col. 7 top).

The Examiner has stated that Schmid also shows Silicon. In col. 7 top are the examples for the electrode materials. It is clearly shown that the Example I in which the Germanium appears, does not show the addition of silicon. Conversely, those examples where Silicon is an element do not contain Germanium. Moreover, since the composing elements for the alloy as recited in claims 20 and 30 are given as %ages relative to the content of the Germanium, these additional elements are also distinguishable from the Schmid reference. In particular, up to 20% of the 3% of Germanium in Silicon amounts to about 0.6%.

Accordingly, it is applicants' contention that the alloy as disclosed by Schmid is very different and patentably distinguished over Schmid in that Schmid does not disclose a medical instrument for use in surgical procedures made from an alloy comprising from 0.01% to 3% by weight of germanium; between 0% to 25% by weight relative to the germanium of at least one of a non-hydrogenic and shallow hydrogenic acceptor dopant; up to 20% by weight of one or more of the

compounds selected from the group consisting of platinum, gold, palladium, iridium, ruthenium, osmium, rhodium, niobium, tantalum, tungsten, aluminum, silicon, zirconium, rare earth elements including hafnium, yttrium and lanthanum; and as a remainder up to 100% by total weight constituted by silver, and wherein the instrument is coated partially or completely with one or more of a material selected from the group consisting of biocompatible, insulating, semi-insulating compounds and ceramic materials.

Therefore, the rejection of claim 20 and 30 under 35 U.S.C. §102(a) as being anticipated by Schmid has now been overcome.

With respect to claim 23, the Examiner states that the Office takes the position that the Schmid electrode is implantable. The Examiner's contention must be rejected since there is nothing in the Schmid reference that points to the possibility of implantation. Those skilled in the art also would understand that the type of electrode that is disclosed in Schmid is a contact electrode and not suitable for implantation. This is supported by the language in the Schmid reference col. 1, lines 58 to col. 2, lines 1-14. From this it is clear that the electrodes are topical and not surgical.

As for the dependent claims 24, 25, 31, 32 these share the same features as claims 20 respectively claim 30 and therefore likewise distinguish over the Schmid reference.

With respect to claim 36, the Examiner stated that the non-hydrogenic and acceptor dopants are also disclosed in Schmid. However, the alloys, as disclosed there, do not disclose the same composition as recited in claims 20. As claim 36

depends from claim 20, the rejection thereof is likewise overcome.

Withdrawal of the rejection of claims 20, 23-25, 30-32 and 36-37 under 35 U.S.C. §102(b) is thus respectfully requested.

REJECTION OF CLAIMS 33-34, 38-40, 43-45 AND 47 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER SCHMID

The Examiner has now rejected the original claims as unpatentable over Schmid. The Examiner has admitted that the Schmid reference fails to disclose the parameters and dimensions such as alloy weight ratios, hardness and conductivity. Nonetheless, the Examiner claims that routine experimentation would result in an electrode with optimal parameters and dimensions.

It is noted that the Schmid reference only discloses one example in which no mercury and graphite is added to the composition. Both mercury and graphite however would not work in a silver alloy surgical instrument as claimed.

Applicant traverses the Examiner's argument that the claimed invention is obvious due to "routine experimentation". It is applicant's contention that the Schmid reference does not constitute a reference which a person skilled in the art would consider when attempting to solve the problems addressed by the present invention. In this connection, reference is made to the decision In re Clay, 23 USPQ2d 1058 (CAFC, June 10, 1992) which discussed the question of "analogous art". As pointed out by the Court, there are two criteria for determining whether prior art is analogous: (1) whether the art is from the same

field of endeavor, regardless of the problem addressed, and (2) if the reference is not within the field of the inventor's endeavor, whether the reference still is reasonably pertinent to the particular problem with which the inventor is involved. While Schmid refers to a topical EKG electrode, the present invention relates to surgical instruments and in particular is faced with the problem of surgery. Thus, the cited reference is not within the field of applicant's endeavor, and are not concerned with the problems facing applicant in the context of surgery. Therefore, it is applicant's contention that Schmid is non-analogous art which a person skilled in the art would not refer to when "experimenting". The features of the presently presented claims 33-34, 38-40, 43-45 and 47 are nowhere found in the Schmid reference.

With respect to claims 43 and 45 the Examiner has taken the position that the Schmid reference is "*structurally equivalent*", that is, the Schmid electrode makes obvious an alloy capable of emitting anions as well being resistant to corrosion.

The applicant disagrees with this characterization since the structure of the Schmid electrode is suitable only to a topical electrode used exclusively for EKG readings from a body (see also col. 7, lines 63-to col. 8 lines, 1-60). The properties of the alloy of the claimed surgical instrument and the Schmid electrode are therefore very different and not comparable as the foregoing discussion shows. While one certainly hopes that surgical instruments are resistant to corrosion and many are capable of emitting anions, they do, however, not teach the claimed surgical instrument.

Withdrawal of the rejection of claims 33-34, 38-40, 43-45 and 47 under 35 U.S.C. §103(a) and allowance thereof are thus respectfully requested.

REJECTION OF CLAIM 21 UNDER 35 U.S.C. §103(a) AS BEING UNPATENTABLE OVER SCHMID IN VIEW OF ROBICHAUD

The rejection of claim 21 as well as the following rejections of features in the claims are respectfully traversed.

Moreover, it is applicant's contention that the Examiner relied upon hindsight to arrive at the determination of obviousness. It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teachings of the prior art so that the claimed invention is rendered obvious. In re Gorman, 933 F.2d 982. In the case at hand, Schmid clearly teaches the desire to improve a topical EKG electrode, as discussed above in detail. Robichaud teaches likewise an EKG electrode. There is no teaching or suggestion supporting the combination of the laminate as proposed by the Examiner. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Gordon, 733 F.2d at 902. But even if the two, Schmid and Robichaud are combined, their teachings do not suggest nor teach the substance of claim 21.

Withdrawal of the rejection of claim 21 under 35 U.S.C. §103(a) and allowance thereof are thus respectfully requested.

**REJECTION OF CLAIM 21 UNDER 35 U.S.C. §103(a) AS BEING
UNPATENTABLE OVER SCHMID IN VIEW OF UEDA**

Applicant respectfully disagrees with the Examiner's rejection of claim 22 for the following reason:

The fusion method of an electrode as taught by Ueda has nothing to do with the claimed invention. While the Examiner takes the position that Schmid is analogous to Ueda, that reference is directed to electrodes useful for electrolysis apparatuses for sea water. Thus, Ueda, despite the Examiner's contention does not seem to be analogous art. Moreover, neither Schmid nor Ueda are on the analogous art with the surgical instrument of the present invention. For the reasons set forth above, it is applicant's contention that neither Schmid nor Ueda, nor a combination thereof teaches or suggests the features of the present invention, as recited in claim 22.

Claim 22 which depends from claim 20 and therefore contains all the limitations thereof, patentably distinguishes over the applied prior art in the same manner as claim 20.

Withdrawal of the rejection of claim 22 under 35 U.S.C. §103(a) and allowance thereof are thus respectfully requested.

**REJECTION OF CLAIMS 35 AND 41-42 UNDER 35 U.S.C. §103(a) AS BEING
UNPATENTABLE OVER SCHMID IN VIEW OF KIYAMA**

The Examiner's rejection is respectfully traversed. The Examiner has taken the position that Schmid would obviously be capable of emitting RF and thermal energy. However, especially with the RF emission, Schmid is entirely silent on this point. In fact, the surgical instrument according to the present invention is composed to emit RF which is possible due to suitably low percentages of the compounds of the composition. All of this is not taught by Schmid. There is likewise no motivation to combine Schmid with Kiyama since Schmid is not concerned with the microcrystal structure and nowhere in Schmid is the desirability of micro crystals mentioned. Besides, Schmid is concerned predominantly with the configuration of the electrode assembly than the electrode itself and the electrode as taught is of a conventional type. Neither matrices nor emission of infrared in the electromagnetic spectrum as claimed is mentioned in Schmid.

Kiyama teaches a photovoltaic process for a solar cell. One would not consult Kiyama if micro crystals were at all desired in the Schmid electrode. There is here absolutely no motivation to modify the Schmid reference with Kiyama.

Withdrawal of the rejection of claims 3 and 41-42 under 35 U.S.C. §103(a) and allowance thereof are thus respectfully requested.

**REJECTION OF CLAIM 46 UNDER 35 U.S.C. §103(a) AS BEING
UNPATENTABLE OVER SCHMID IN VIEW OF POPP**

The rejection is respectfully traversed. The rejection is confusing in that the Examiner states that the Kiyama reference discloses fractal surfaces. Since the Kiyama reference is not at issue here it is believed that the Examiner is referring to the Popp reference.

The Examiner admits that fractal surfaces are neither disclosed nor taught by Schmid. He combines therefore the Popp reference to postulate that fractal surfaces would be a design expedient and therefore could be combined with Schmid. Again, there is absolutely no motivation to include fractal surfaces in Schmid since Schmid is not concerned with energy distribution since no RF emission is taught nor in particular with electronic storage as in Popp. Consequently, the combination of the two references also lacks relevance.

Withdrawal of the rejection of claims 3 and 41-42 under 35 U.S.C. §103(a) and allowance thereof are thus respectfully requested.

CLARIFICATION AMENDMENT

Applicant has also amended the specification in paragraph [0020] to clarify an ambiguity as to the inclusion of 0% and to support the amendment in claims 20 and 30. As the specification throughout indicates that the percentage

weight of the dopant is a range between 0% and a higher value, this change does not introduce any new matter.

INFORMATION DISCLOSURE STATEMENT

It is noted that the Examiner has not considered the references as submitted with the Information Disclosure Statement, as filed on December 2, 2003. Applicant requests that the Information Disclosure Statement should be considered and made of record.

CONCLUSION

Applicant believes that when reconsidering the claims in the light of the above comments, the Examiner will agree that the invention is in no way properly met or anticipated or even suggested by any of the references however they are considered.

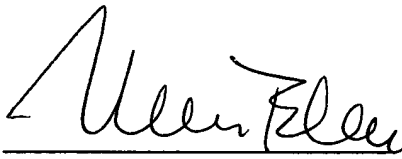
None of the references discloses a surgical instrument, device or mono- or pluripolar electrode from an alloy as claimed.

In view of the above presented remarks and amendments, it is respectfully submitted that all claims on file should be considered patentably differentiated over the art and should be allowed.

Reconsideration and allowance of the present application are respectfully requested.

Should the Examiner consider necessary or desirable any formal changes anywhere in the specification, claims and/or drawing, then it is respectfully requested that such changes be made by Examiner's Amendment, if the Examiner feels this would facilitate passage of the case to issuance. If the Examiner feels that it might be helpful in advancing this case by calling the undersigned, applicant would greatly appreciate such a telephone interview.

Respectfully submitted,

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